

### **REMARKS**

Claims 1-20 are currently pending. In the Office Action of September 12, 2007, the Examiner maintained the restriction requirement of March 20, 2007 and withdrew claims 12-14, 17, 19, and 20 from consideration. For the additional reasons set forth below, Applicant requests reconsideration of the restriction requirement. Substantively, the Examiner rejected claims 1-11, 15, 16, and 18 under 35 U.S.C. §112, first and second paragraph. The Examiner next rejected claims 2-11, 16, and 18 under 37 C.F.R. §1.75(c) as failing to further limit the subject matter of the claims from which they depend. The Examiner also rejected claim 1 under non-statutory obviousness-type double patenting in view of Applicant's co-pending U.S. Patent Application Ser. No. 11/572,297.

#### **The Restriction Requirement**

This latest Office Action, including the comments regarding Applicant's remarks directed to the impropriety of the restriction, is curious in light of the Pre-Appeal Brief Conference Request of February 2, 2007. For example, the Examiner states:

Applicant argues 1) the restriction without addressing the subject matter of the groups and amend the claims with New matters (single consolidation and multilayer are joined together to form a whole with pointing out support), then concludes he is uncertain how the restriction analysis of group I and group II renders the claims set patentably distinct.

Applicant has failed to address what the claimed invention is of Group I and Group II as now amended and how they cover the same subject matter without undue burden on the Examiner.

Office Action of September 12, 2007, pg. 2, ¶1.

As fully set forth in Applicant's traversal, the example the Examiner provided as to why claim 1 is patentably distinct from claim 12, is applicable to either of claims 1 and 12. Simply, the Examiner's reasoning is devoid of any consideration of what is claimed. That is, neither of claims 1 or 12 is limited to molding, layering, stamping, or pressing. As stated in Applicant's

remarks, the “examples provided by the Examiner are applicable to the claims of both Group I and Group II.” Applicant’s uncertainty stems from the similarities of the claims and the Examiner’s interpretation thereof which seems to be inconsistent with the reasoning presented.

Even prior to Applicant’s amendment, claim 1 called for, in part, a product made out of a substrate of a fiber reinforced thermoplastic product with randomly distributed fibres having a specified density. Claim 1 further calls for cover layers that at least partly cover adjacent sides of the substrate and have a continuous fibre reinforced thermoplastic product that bonds at the substrate to form a single consolidation in which the respective fibres are oriented approximately parallel to one another.

Comparatively, claim 12 calls for, in part, a process of manufacturing a product that comprises at least partly covering each side of a substrate with a cover layer. The substrate is further defined as being a fibre reinforced thermoplastic product with randomly distributed fibres. The cover layer is defined as partly covering each side of the substrate and as being a continuous fibred reinforced thermoplastic with fibres oriented parallel to one another. Claim 12 further defines consolidating the product of the substrate and the product of the cover layers. The claims themselves provide evidence of Applicant’s confusion with respect to the Examiner’s insistence that either one of them is solely related to the processes of molding, layering, stamping, or pressing which the Examiner relied on in imposing the restriction.

The Examiner’s assertion that Applicant also failed to address any undue burden on the Examiner is incorrect. In fact, paragraphs 1 and 2 on page 9 of the previous response provide evidence of the lack of a burden on the Examiner that could be considered sufficient to insist on the restriction. The Examiner clearly considers such a requirement to be subjective in as much as this application has been previously prosecuted to a Pre-Appeal Brief Conference Request without meeting the requisite burden threshold. Even further, the currently pending claims have no outstanding prior art rejections absent a provisional obviousness-type double patenting rejection. Applicant’s arguments presented on pages 8 and 9 of the Response of May 21, 2007

provide that 1) a valid restriction must prove a burden on the Examiner as stated in MPEP §803 and 2) the reasoning as to why the Examiner has a sudden burden lacks merit. As stated therein, regardless of which Group of claims Applicant elects, all of the classes identified by the Examiner would necessarily have to be searched. Accordingly, Applicant requests reconsideration of the Restriction requirement in accordance with 37 C.F.R. §1.144.

**35 U.S.C. §112, first and second paragraph rejections**

The Examiner substantively rejected claims 1-11, 15, 16, and 18 under 35 U.S.C. §112, first and second paragraph. With respect to the §112, first paragraph rejections, the Examiner maintains that there is inadequate written description or an enabling disclosure sufficient to support the recitation of “to form a single consolidated product” in claim 1 or “a painted multilayer product ... are consolidated to form generally a whole” in claim 15. The Examiner posits several questions including:

What temperature and pressure are use[d] to make a single consolidated product ( or consolidated to from a generally whole) of claim 1 and 15;

What defines or constitute the phrase consolidated to form a generally whole;

How to make the single consolidated product (or consolidated to form generally a whole) of claims 1 and 15;

Office Action of September 12, 2007, pg. 3, note 2.

The alleged failing of the present application to enable that which is claimed continues with the statements that “The specification also fails to provide any guide or direction of how to make a single consolidated product (or consolidated to from a generally whole) of claims 1 and 15 and what temperature and pressure are used to form a single consolidated product” and that “The specification has no working examples of how a single consolidated product (or consolidated to form a generally whole) of claims 1 and 15.” The Examiner concludes that “The specification at page 2 lines, 16-17 and page 5 lines 1-6 fails to disclose the final product.”

It is not any given applicant's responsibility to educate those without ordinary skill in the art to make and/or use a claimed invention. For example, page 3 of the application recites various references which disclose alternate working methodologies for forming substrates for products in the realm of the technology currently claimed. That is, Applicant has set the stage of the present invention with that which is already known. The present application states that "... the multilayer product may be moulded into the desired three dimensionally shaped forms by pressing or vacuum consolidating it in a properly shaped mold" and that "the substrate and the film are heated together under pressure at a temperature to assure good bonding between the substrate and the film." Thus, Applicant has sufficiently enabled those skilled in the art, without regard to a novice thereto, to practice the claimed invention.

The Examiner alleges that Applicant's failure to disclose a consolidation temperature and pressure yields a failure to enable or disclose that which is claimed. Again, the Examiner makes a statement that is – on its face – not true. The Examiner's attention is directed to claim 13 of the originally filed application. Claim 13 of the originally filed application discloses an exemplary consolidation pressure of at least above ambient and that an applicable temperature is above the glass transition temperature of the thermoplastic material of the substrate. Such disclosure is more than adequate to meet the requirements of 35 U.S.C. Thus, contrary to the Examiner's assertion, the application clearly discloses and enables that which is called for in the present claims.

The Examiner further alleges that the phrases "consolidated to form generally a whole" and "isotropic" are vague and indefinite. The Examiner further asserts that recitation of "isotropic" is "indefinite since this is a subjective limitation which can change from person to person." Applicant respectfully disagrees.

Even one absent ordinary skill in the art would appreciate the plain and ordinary meanings of these terms. They are terms having an ordinary English meaning and as such understandable not only by one of ordinary skill in the art but also one without ordinary skill in the art. For example, as presented in previous papers, something that is “consolidated” is joined together into one whole. Applicant has already explained this. (See Response of February 2, 2007). Moreover, one of ordinary skill in the art would further appreciate that something that is described as “isotropic” is something that exhibits properties with the same values when measured along axes in all directions. The citation provided by the Examiner with respect to Applicant’s usage of the term “isotropic” removes the term from its context. To be accurate, the claim describes both the orientation and the makeup of the respective layers in defining the product, which is constructed from the respective layers, as being isotropic. Certainly, one with ordinary skill in the art would appreciate as much.

The Examiner also alleges that claims 1 and 15 are overall vague and indefinite “since they omit any transitional phrase.” Notably, the Examiner failed to cite, and Applicant failed to find, any requirement that a claim must include a transitional phrase. In fact, 37 C.F.R. §1.75 tempers the use of preambles and transitional phrases in requiring them only “where the nature of the case admits.” Nonetheless, Applicant has amended each of the pending claims to address the rejection and thereby remove those issues from appeal.

With respect to the remainder of the Examiner’s §112, first and second paragraph rejections, Applicant has amended each of the pending claims to resolve and remove the issues cited by the Examiner other than those addressed above. Accordingly, those rejections not addressed above are believed to be overcome by the amendments to the claims.

**37 C.F.R. §1.75(c) rejection of dependent claims**

The Examiner rejected each of the pending dependant claims asserting that “The final product form[ed] by claims 1 and 15 is a single consolidated product (or consolidated to form generally a whole) and thus the cover layer and the substrate (intermediate product) are no longer present when the final product is formed.” Applicant finds such a rejection to be untenable.

Title 35 U.S.C. §112, fourth paragraph, statutorily defines the requirement of the content of a dependent claim. As stated therein “a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.” Emphasis added. That is, an Applicant is not required to add something to the subject matter of the independent claim but can further define any of that which is called for therein. For example, claim 1 calls for a substrate being a fibre reinforced thermoplastic product. Claim 2 further defines the product of claim 1 stating that the fibres of the substrate have an average length of between about 7 and 200 millimetres. Assuming, for the sake of argument, that the Examiner’s position has merit, defining the length of the substrate fibres further defines the product as including fibres of such length. Simply, the Examiner’s interpretation of this rule is not correct.

**Obviousness-type Double Patenting Rejection**

The Examiner provisionally rejected claim 1 as being unpatentable over claim 19 of co-pending application U.S. Ser. No. 11/572,297. MPEP §822.01 states that if a provisional double patenting rejection is the only remaining rejection, the Examiner should withdraw that rejection and permit the application to issue as a patent. Accordingly, in view of the remarks and amendments presented herein, Applicant believes claims 1-11, 15-16, and 18 are in condition for allowance.

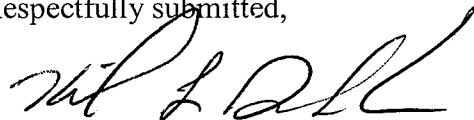
### **Interview Summary**

With respect to the Interview Summary the Examiner attached to the September 12, 2007 Office Action, Applicant offers the following clarifying remarks. Applicant queried the Examiner as to where in the prosecution history the alleged new matter rejection could be found. With respect to Applicant's communications with Supervisory Patent Examiner Dye, Applicant defers to the prosecution history regarding the Office's inferences with respect to the Examiner's conduct in this matter.

### **Conclusion**

At least for the reasons set forth above, Applicant believes the present application is in compliance with the applicable rules. Accordingly, Applicant requests a Notice of Allowance of claims 1-11, 15, 16, and 18. Additionally, upon consideration of the remarks presented herein, Applicant further requests rejoinder of claims 12-14, 17, and 19-20. The Office is hereby authorized to charge Deposit Account No. 50-1170 the amount of \$460.00 for a two-month extension of time for entry and consideration of this response if such fee has not been previously assessed.

Respectfully submitted,



Kirk L. Deheck  
Registration No. 55,782  
[kld@boylefred.com](mailto:kld@boylefred.com)

Dated: March 24, 2008

USPTO Customer No. 23598  
Boyle Fredrickson, S.C.  
840 North Plankinton Avenue  
Milwaukee, WI 53203  
Telephone: (414) 225-9755  
Facsimile: (414) 225-9753